

REMARKS

Reconsideration is respectfully requested in view of the remarks herein.

Status of the Claims

Claims 5-7, 15-17, 24, 25, 28, 29, 31, 32 and 34 have been withdrawn from consideration by the Examiner. Claims 1-17 and 23-39 are currently pending.

Discussion of the Amendments to the Claims

The claims have been amended to more particularly point out and distinctly claim the subject matter of the present invention and in effort to advance prosecution and not in acquiescence of any rejection. Independent claims 1, 23, and 30 have been amended to recite that the visual marker is colored with a colorant to enhance visualization and is capable of being seen under direct vision within the cavity using a scope without the need of fluoroscopy. Moreover, claim 39 has been amended to recite that the visual marker includes a colorant to enhance visualization and can be seen under direct vision within the cavity using a scope. New claims 40-42 have been added. Support for the amendments to the claims may be found in the application as originally filed at, for example, page 5, lines 1-25, page 6, lines 10-13, page 7, line 31 – page 8, line 1, page 8, lines 15-17, at page 8, line 29 – page 9, line 7, page 9, lines 10-14, page 10, lines 6-11, page 10, lines 22-24, page 11, lines 6-8, and at page 11, lines 20-23. No new matter has been added by way of the amendments to the claims.

Response to the Rejection under 35 U.S.C. §103

Claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, 35, and 39 stand rejected under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent No. 5,653,748 to Strecker (hereinafter “Strecker”) in view of U.S. Publication No. 2003/0121148 A1 to DiCaprio (hereinafter “DiCaprio”). In this regard, the Examiner has alleged that “[i]t would have been obvious to one

having ordinary skill in the art at the time the invention was made to combine the radiopaque bands of DiCaprio with the delivery device of Strecker in order to enhance the trackability of the implant.” (Office Action, page 3). Applicants respectfully traverse the rejection and request reconsideration in view of the amendments and remarks herein.

To advance prosecution and not in acquiescence of the rejection, independent claims 1, 23, and 30 have been amended to recite that the visual marker is colored with a colorant to enhance visualization and is capable of being seen under direct vision using a scope without fluoroscopy. Moreover, claim 39 as presented herein recites that the visual marker includes a colorant to enhance visualization and further recites that the movement of the visual marker can be seen under direct vision within the cavity by the operator by means of the scope without the need of fluoroscopy.

The Examiner’s argument is premised upon combining the radiopaque bands of DiCaprio with the delivery device of Strecker in order to enhance the trackability of the implant. Neither DiCaprio nor Strecker disclose a visual marker which is colored with a colorant to enhance visualization, much less a visual marker which is colored with a colorant to enhance visualization and which is capable of being seen under direct vision without the need of fluoroscopy. Indeed, DiCaprio discloses the use of fluoroscopy to view the radiopaque bands and, as such, teaches away from the present invention as defined by the pending claims. *See* column 2, paragraph [0038], of DiCaprio, wherein DiCaprio explicitly discloses that radiopaque markers would “allow an operator to easily view the stents using fluoroscopy.” (Emphasis added).

In view of the foregoing, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. §103(a) with regard to claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, 35, and 39.

Response to the Rejection under 35 U.S.C. §103(a) in view of Strecker, DiCaprio, and Ravenscroft

Claims 9-11 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Strecker as modified by DiCaprio as applied to claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, and 35 in further view of U.S. Patent No. 5,480,423 to Ravenscroft (hereinafter "Ravenscroft"). Reconsideration is respectfully requested in view of the remarks and amendments herein.

Claim 9 depends from claim 1. Strecker and DiCaprio fail to disclose or suggest the subject matter of claim 1 for the reasons discussed above. As such, Strecker and DiCaprio fail to disclose or suggest the subject matter of claim 9 for the same reasons discussed above with respect to claim 1. Indeed, there is no disclosure or suggestion in Strecker and DiCaprio of the subject matter of claim 9.

Moreover, Ravenscroft fails to disclose or suggest the subject matter of claim 9 as presented herein. As such, Ravenscroft fails to overcome the deficiencies of Strecker and DiCaprio.

In view of the foregoing, claims 9-11 are not obvious in view of the cited combination of Strecker, DiCaprio, and Ravenscroft. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a) in view of Strecker, DiCaprio, and Ravenscroft.

Response to the Rejection under 35 U.S.C. §103(a) in view of Strecker, DiCaprio and Fischell

Claims 36-38 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Strecker as modified by DiCaprio as applied to claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, and 35 in further view of U.S. Patent No. 5,792,144 to Fischell et al. (hereinafter "Fischell"). Reconsideration is respectfully requested in view of the remarks and amendments herein.

Claims 36-38 all depend from claim 1, either directly or indirectly. Strecker and DiCaprio fail to disclose or suggest the subject matter of claim 1 for the reasons discussed above. As such, Strecker and DiCaprio fail to disclose or suggest the subject matter of claims 36-38 for the same reasons discussed with respect to claim 1. Indeed, there is no disclosure or suggestion in Strecker and DiCaprio of the subject matter of claims 36-38.

Moreover, Fischell fails to disclose or suggest the subject matter of claims 36-38 as presented herein. As such, Fischell fails to overcome the deficiencies of Strecker and DiCaprio.

In view of the foregoing, claims 36-38 are not obvious in view of the cited combination of Strecker, DiCaprio, and Fischell. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a) in view of Strecker, DiCaprio, and Fischell.

Concluding Remarks

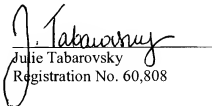
An allowance of the claims is respectfully requested. Should the Examiner have any questions or comments concerning the foregoing, the Examiner is respectfully invited to contact the undersigned at the telephone number given below.

No fees are deemed to be due in connection with this Communication. However, the Commissioner is hereby authorized to charge payment of any fees associated with this

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communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Respectfully submitted,


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